REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-3, 6, 7, 9, and 10 are currently pending. Claims 1, 7, 9, and 10 are independent.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-3, 6, 7, 9 and were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,697,948 to Rabin *et al.* (herein after,"Rabin") in view of U.S. Patent No. 5,790,935 to Payton and further in view of U.S. Patent No. 6,470,085 to Uranaka *at al.* (herein after, "Uranaka").

Applicant respectfully traverses this rejection.

A. THE OFFICE ACTION FAILS TO ADDRESS EACH AND EVERY ELEMENT RECITED IN THE CLAIMS

Independent claim 1 is representative and recites, *inter alia*:

"warning by warning report data when the status code information crosses the threshold value,
. . .
. . . a selection of using an electronic mail or displaying the warning report on the screen is determined based on a predetermined report method in the output setting information. "

. . .

> disabling use of the contents stored on the memory storage device when said status code information exceeds the threshold value of said output setting information." (emphasis added).

The cited references do not disclose output setting information that includes both the threshold values AND report method information, and report address information.

The focus is in on characteristic elements of the "output setting information."

Applicants incorporate by reference their discussion and arguments presented in reply to the previous Office Action that, for brevity, are not repeated here.

The Office Action **does not address** this element of the claim. The Office Action states, "With regards to the claimed limitation of '**sending said warning report by a selected method . . . when said status code information nears the threshold value**' . . ." (see claim 1), the USPTO considers this element to be **optional language.**" (emphasis in original). [The Office Action then points to *In re Johnston*, 77 U.S.P.Q.2d 1788 (CAFC 2006), which is both misquoted and inapposite as discussed below].

Applicants assert the claim term "when" is not "optional language." Applicant asks for reconsideration. Applicant points to **MPEP 2173.05(g)**, which, on an unrelated topic cites with favor the use of "when" in a CAFC case:

> "In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted . . . the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<" (emphasis added).

Moreover, the term "when" is used clearly throughout the specification. The Federal Circuit has held the claim term "when" is neither indefinite nor ambiguous and can provide a limitation on claim scope. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998) and progeny. The term "when" has the meaning as used in the specification. 158 F.3d at 1251-1252. In the present application the term "when" is described throughout the specification as, for example, ". . . the warning report data WID is outputted when status code information SC exceeds the output setting information OI." Publ. App. Abstract.

The Office Action at page 5, par. 17, "Response to Arguments," takes out of context and misapplies *In re Johnston*, 435 F.3d 1381; 77 U.S.P.Q.2d 1788 (Fed. Cir. 2006). The Office Action states:

> ". . . the USPTO interprets claim limitations that contain '**if, may, might, can, when** and **could'** statement(s), as **optional** language. As a matter of linguistic precision, optional claim elements do not narrow claim interpretation, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (CA FC 2006))." (emphasis in OA)

The *Johnston* court **did not** hold, nor even discuss in dicta, use of the term "when" or even suggest overruling *Renishaw*, discussed above. The **complete** quote from *Johnston* is:

> "Claim 3 [recites] 'further including that said wall **may** be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased.' The Board ruled that this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form **"may**." As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted." *Johnston* at 1386.

Thus, it is overwhelmingly clear and beyond dispute that the CAFC was referring to the word "may" as not narrowing claim scope. The CAFC was referring to the word "may" when stating, "As a matter of linguistic precision, optional elements do not narrow the claim because

they can always be omitted." The CAFC **was not** referring to the word "when" used in claims, as implied in the Office Action.

Applicant cannot find the quote to which the Office Action is pointing that identifies the word "when" in claim language as indefinite or permissive. Moreover, while not dispositive it is persuasive that Applicant's representative has located in excess of 850,000 utility patents granted in the last 20 years that use the term "when" in the claims.[1]

None of the references cited includes an output setting information that includes the elements of threshold values for contents usage rights AND, when the threshold is neared, the output setting information is consulted to determine the method of sending the warming report.

The above recited feature of claim 1 is not disclosed in any of the cited references.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 7, 9 and 10 are also believed to be patentable.

B. THE OFFICE ACTION FAILS TO ADDRESS THE FEATURES OF EACH AND EVERY **DEPENDENT CLAIM**

1. THE OFFICE ACTION FAILS TO ADDRESS THE FEATURES **CLAIM 2**

Claim 2 depends from claim 1 and recites, *inter alia*:

[1] The actual number is 869,338. Applicant's searched using www.freepatentsonline.com/search.html with the search criteria, "ACLM/when"

"A contents control method according to claim 1, further comprising outputting invalidation report data when the use of said contents has been disabled."

The Office Action fails to address this specific element recited in claim 2. The Office fails to point to any place in any of the cited references where this element is disclosed.

2. THE OFFICE ACTION FAILS TO ADDRESS THE FEATURES **CLAIM 3**

Claim 3, depends from claim 2 and recites, *inter alia*:

"A contents control method according to claim 2, further comprising outputting deletion report data when said contents are deleted."

The Office Action fails to address this specific element recited in claim 3. The Office fails to point to any place in any of the cited references where this element is disclosed. The Office Action suggests disclosure of deleting contents but **does not** point to a location in the cited art disclosing "outputting **deletion report data** when said contents are deleted."

III. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 1-3, 6, 7, 9 and 10 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited

reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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